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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,321	11/26/2001	Peter T. O'Heeron	18408.0016	7380

7590

01/26/2004

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

9

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,321

Applicant(s)

O'HEERON ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Jan. 14, 2004 has been entered.

Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer et al. (5,441,041) and Goodwin et al. (5,817,061), each in view of the other. Sauer al. disclose housing assembly 52, cannula assembly 54, obturator assembly 12 comprising a shaft 20 having a piercing end with a piercing tip (figure 4) with an upper face (e.g. 28f) and a lower face (e.g. 28g) which taper from the shaft, insert blade 34 comprising a non-conical head (at the tip) and two wing elements (the sides which form an obtuse angle) having lateral edges. The Sauer et al. disclosure is silent as to whether the blade head is blunt or sharp. However, Goodwin et al. teach that blade edges on an obturator tip should be blunt in order to perform blunt dissection of tissue (col. 4, lines 36-39). This has the self-evident advantage of preventing inadvertent cutting of tissue while still permitting the dissection of tissue when desired.

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It would have been obvious to make the blade edges of Sauer al. blunt so that it too would have this advantage. With this modification, the head of the Sauer et al. blade (at the tip) would be blunt as claimed. Sauer et al. fail to disclose the piecing tip as being removable from the shaft. However, Goodwin et al. teach that a piercing tip of a trocar should be removable from the shaft so that it can be replaced with another tip (col. 4, lines 19-26 and col. 5, lines 20-29). It would have been obvious to make the Sauer et al. piecing tip removable from the shaft so that it too would have this advantage. Alternatively, Goodwin et al. disclose blunt edged blades 18 but fail to disclose that they meet to form a single "blade". However, Sauer et al. teach that blade edges (at 34) on a conical obturator should extend to the tip (or head) of the obturator and meet and thus form a blade apparently in order to dissect tissue effectively (figures 2A-5a, col. 3, lines 53-63 and col. 5, lines 19-24). It would have been obvious to extend blades 18 of Goodwin et al. to the tip of the obturator and meet and thus form a blade so that it too would have this advantage. As to claim 7, neither reference discloses metal as the blade material. However, it was well known to use metal as the material for obturator blades so that they are strong. It would have been obvious to make the blade of either reference metal so

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that it too would have this advantage. The above well known in the art statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertion (M.P.E.P. 2144.03).

Applicant's arguments filed Jan. 14, 2004 have been fully considered but they are not persuasive. Although Sauer et al. reference refers to the blade as a cutting blade, it is silent as to whether the cutting involves blunt dissection caused by a blunt blade or cutting caused by a sharp blade. Making the Sauer et al. blade blunt would not be counter to the basic principle under which the reference was designed to operate since the separation of tissue would still occur to facilitate the penetration of tissue. However, the separation of tissue would be performed using a blunt blade. As to the portion of the rejection wherein Sauer et al. is the secondary reference, this reference clearly teaches that blade edges (at 34) on a conical obturator should extend to the tip (or head) of the obturator and meet and thus form a blade.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114.

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone number for the

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organization where this application or proceeding is assigned is
(703)872-9306.

Any inquiry of a general nature or relating to the status
of this application or proceeding should be directed to the
receptionist whose telephone number is (703)308-0858.

mht
1/22/04



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731